

Amendment Under 37 C.F.R. § 1.116
Serial No.: 10/019,669
Sughrue Ref: A7705

REMARKS

Claims 1-40 are all the claims pending in the application. Claims 1, 25, 31, 35, and 38 are independent claims.

Claims 33, 34, 37, 39, and 40 have been withdrawn from consideration by the Examiner because they are directed to a non-elected invention. Applicant respectfully requests the Examiner to allow the withdrawn claims in the event that a linking claim is allowed.

The rest of the claims have been examined.

Allowable Subject Matter

Claims 3, 6, 9, and 12-30 are allowed.

Claim Rejections Under 35 U.S.C. § 112

Claims 31 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite.

It is the Examiner's position that it is not clear what structural limitations are encompassed by the recitation "adaptable for treating a weight bearing area of a human foot." In response, Applicant has amended claim 31 to recite that the insole assembly includes "an oval opening within at least one of the insole layers adapted to be directly under an area of a human foot" and respectfully request the Examiner to withdraw the §112, second paragraph, rejection in view of this amendment.

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Claim Rejections Under 35 U.S.C. § 102 and §103

Claims 35, 36, and 38

Claims 35, 36, and 38 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Darby et al. (US 5,370,133).

It appears to be the Examiner's position that Darby '133 discloses a shoe having an outsole 16 and a circumferential counter 16a that is a portion of the outsole 16. In addition, it appears that the Examiner considers the rounded heel counter 34 as being a portion of the outsole 16 and the vertical edge 32 of the counter 34 as corresponding to the recited "fitting marker".

As such, Applicant has amended claims 35 and 38 to recite that the fitting marker is "molded into the side surface of the out sole" and is "provided below the circumferential counter." These amendments are fully supported by the original specification at least by the non-limiting embodiment shown in Fig. 2 and discussed at paragraph 27 of the original specification.

Applicant respectfully submits that the vertical edge 32 of the of Darby '133's counter 34 cannot correspond to the recited "fitting marker" because it is not molded into the side surface of the walking sole 16 and is not provided below the counter 16a. See Darby '133 at Fig. 1.

As such, Applicant respectfully requests the Examiner to withdraw the rejection of independent claims 35 and 38. In addition, Applicant further requests the Examiner to withdraw the rejection of dependent claim 36 at least because of its dependency from claim 35.

Claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 and 32

Claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Darby (US 5,491,909) in view of Darby '133, and further in view of

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Grim et al. (US 5,329,705). Claim 32 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Darby '909 in view of Darby '133 and Grim as applied to claim 31, and further in view of Kellerman et al. (US 5,799,414).

It appears to be the Examiner's position that the layers of Grim's inner sole assembly 12, e.g., upper resilient layer 66 and bladder 64 (made up of thin sheet urethane 92, cloth material 94, and foam layer 96), are separably removable because they are removable and separated from the support member 20. *See* Grim at Figs. 2 and 3.

As such, Applicant has amended independent claims 1 and 31 to further describe what was is meant by "separably removable." Specifically, Applicant has amended independent claims 1 and 31 to recite that the insole layers are stacked on top of one another, and that the insole layers are capable of being rearranged so as to be stacked in different orders. These claim amendments are fully supported by the original specification at least by the non-limiting embodiment shown in Figs. 3, 4, 5B, and 8-13 and the discussion thereof in the original specification.

Applicant respectfully submits that the layers of Grimm's inner sole assembly 12 (e.g., upper resilient layer 66 and bladder 64) are not capable of being rearranged so as to be stacked in different orders. Instead, the layers are provided in a single order and remain arranged in that order.

In contrast, the claimed invention, in which the insole layers are capable of being rearranged so as to be stacked in different orders, allows the insole layers to be rearranged based on the recommendations of a health care professional.

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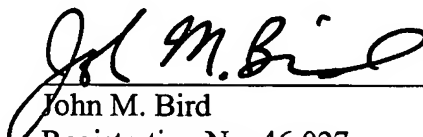
Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of independent claims 1 and 31. In addition, Applicant further requests the Examiner to withdraw the rejection of dependent claims 2, 4, 5, 7, 8, 10, and 11 at least because of their dependency from claim 35, and requests the Examiner to withdraw the rejection of dependent claim 32 at least because of its dependency from claim 31 and because Kellerman (which the Examiner alleges as showing an opening with a skived edge) does not cure the deficiencies in the combination of Darby '909, Darby '133 and Grim discussed above.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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